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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,409	02/10/2004	David C. Kelman	10557/296452	2422
36559	7590	11/24/2009		
DIANA HOUSTON SMITH & NEPHEW, INC. 1450 BROOKS ROAD MEMPHIS, TN 38116				
EXAMINER				
COMSTOCK, DAVID C				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
11/24/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/776,409

**Applicant(s)**

KELMAN, DAVID C.

**Examiner**

DAVID COMSTOCK

**Art Unit**

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14, 24-28, 30-41 and 52-62 is/are pending in the application.
- 4a) Of the above claim(s) 1-14, 53, 58-60 and 62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-28, 30-41, 52, 54-57 and 61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :5/21/07, 6/1/07, 1/10/08, 3/13/08, 4/9/08, 6/9/08, 8/21/08, 1/28/09, 2/13/09, 5/4/09, 8/7/09, and 10/27/09.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of species I, claims 24-28, 30-41, 52, 54-57 and 61, in the reply filed on 22 June 2009 is acknowledged. Claims 1-14, 53, 58-60 and 62 were withdrawn from further consideration by Applicant. In addition, Applicant canceled claims 15-23, 29 and 42-51. Applicant did not indicate whether the election was without traverse but did not point out any alleged errors in the requirement; accordingly, the election filed 22 June 2009 has been treated as having been made without traverse.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24-28, 30-41, 52, 54-57 and 61 are rejected under 35 U.S.C. 102(b) as being anticipated by Kampner (US Patent Number 5,571,193).

Kampner discloses various embodiments of a system for stabilization of an implant in bone tissue of a human or an animal, comprising a prosthetic implant, e.g. 1A and 1B, and a hybrid resorbable device comprising at least one resorbable component, e.g. 6, and one non-resorbable component, e.g. 8, wherein the resorbable device is inserted into a cavity between the implant and the bone tissue of the human or the

animal, and wherein the resorbable device is at least partially resorbed over a predetermined period of time, wherein the resorbable device comprises a resorbable polymer, wherein the resorbable polymer is poly-L-lactic acid, polyglactin acid, or a combination thereof, wherein the resorbable device further comprises calcium sulphate, calcium phosphate or a combination thereof, wherein the resorbable device further comprises a bioactive molecule, wherein the bioactive molecule is a growth factor or antibiotic, wherein the resorbable device is a spacer having a predetermined shape that at least partially fills the cavity to reduce movements of the implant relative to the bone, wherein the resorbable device is inserted during a joint replacement surgery, wherein the prosthetic implant is a hip implant, a knee implant, a shoulder implant, or an elbow implant, or a component thereof, wherein the prosthetic implant or the component thereof is inserted into an intramedullary canal of a tubular bone, and wherein the resorbable device is inserted into the cavity between the bone and the prosthetic implant, further comprising an allograft bone, resorbable granules, or a combination thereof, wherein the joint replacement surgery is revision surgery, wherein the implant is a hip replacement comprising a femoral stem, wherein the femoral stem is inserted into the femoral canal, and wherein the resorbable device is inserted into the cavity between a cortex of the femur and the femoral stem of the hip implant, wherein the hybrid resorbable device is a peg, comprising a locking shoulder portion, and a peg portion, and wherein the non-resorbable component is the locking shoulder portion, and the resorbable component is the peg portion, wherein the implant is an acetabular component of a hip implant comprising openings, e.g. 18, and the hybrid resorbable

device, e.g. 20, is inserted through the openings into the bone (see figures 1 and column 3, lines 29-36 and column 4, lines 45-57).

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Kampner, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). In addition, the process by which the device is intended to be made (e.g., claims 54 and 55) has not been given patentable weight since the claims are drawn to an apparatus (as opposed to a method or process of making the device) and the claimed process does not result in a patentably distinct final product. As in applicant's claims, the resorbable and non-resorbable components of the prior art are attached to each other.

### ***Response to Arguments***

Applicant's arguments filed 20 August 2007 have been fully considered but they are not persuasive.

It is noted that the noted portions of the device of Kampner satisfy the claimed invention. Specifically, the resorbable component can be characterized at least as a peg or a spike. Moreover, the top portion of the non-resorbable component shown in the figures set forth in the rejection provides cover to the resorbable portion (i.e., that portion of the component closest to arrow 14 provides cover to the resorbable portion). In addition, the resorbable portion is inserted into bone tissue; specifically, it is implanted into a femur.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710 (a detailed message should be left if Examiner is unavailable). If attempts to

reach the Examiner by telephone or voicemail are unsuccessful, the examiner's supervisor, Eduardo Robert, can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733